

a/2510

Office Action Summary

Application No.
09/123,145

Applicant(s)
SEKIGUCHI, Kenzo

Examiner
Joseph Pokrzywa

Group Art Unit
2722



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-39 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-39 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings were not objected to by the Official Draftsperson (see attached PTO-948).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1, 13, 25, 36, and 38** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding *claim 1*, the phrase "such as" in line 2, renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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Regarding *claim 1*, the phrase "and the like" in line 3, renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "and the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Regarding *claim 13*, the phrase "such as" in lines 2 and 3, renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding *claim 13*, the phrase "or the like" in line 3, renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Regarding *claim 25*, the phrase "such as" in line 3, renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding *claim 25*, the phrase "or the like" in line 4, renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Regarding *claim 36*, the phrase "such as" in lines 2 and 3, renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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Regarding *claim 36*, the phrase "or the like" in line 3, renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Regarding *claim 38*, the phrase "such as" in line 2, renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1 through 9, 11, 13 through 21, 23, 25 through 32, 34, and 36 through 39** are rejected under 35 U.S.C. 102(b) as being anticipated by Kulakowski (WIPO Publication Number WO 97/10,668).

Regarding *claim 1*, Kulakowski discloses a communication apparatus (interface device 10, see Figs. 1 and 2) comprising a means for connecting a computer network (network 20, page 8, lines 8 through 15), a means for connecting to a public telephone network (PSTN, page 8, lines 6 through 8), a means (fax interface circuitry 36) for receiving transfer destination information (destination telephone numbers) of e-mail data from the public telephone network (page 9, lines 7

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through 11, page 12, lines 5 through 14, and page 12, line 33 through page 13, line 10), a means (processor 33) for converting the received facsimile image data (page 12, lines 18 through 32) into an e-mail data format (page 13, line 11 through page 14, line 19), and a means (directory 75) for designating an e-mail destination of the computer network on the basis of the received transfer destination information (page 12, line 33 through page 13, line 10), and transmitting the e-mail data converted by the conversion means (processor 33) to the designated destination (page 15, lines 1 through 17).

Regarding *claim 2*, Kulakowski discloses the apparatus discussed in claim 1 above, and further teaches that the transmission means comprises destination designation means for designating the e-mail destination of the computer network on the basis of the received transfer destination information (page 12, line 33 through page 13, line 10), and post-office designation means for designating a desired post-office in an e-mail server of the computer network (page 15, lines 1 through 17, and page 17, lines 6 through 34).

Regarding *claim 3*, Kulakowski discloses the apparatus discussed in claim 1 above, and further teaches that the transfer destination information and password information (page 13, lines 23 through 25) are received from the public telephone network (page 8, lines 22 through 23, and page 13, lines 11 through 31), wherein it is checked if e-mail transfer destination information corresponding to the transfer destination information is set in advance (page 13, lines 11 through 31) and if the received password information matches password information set in advance (being

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inherent in the system), and the converted e-mail data is transmitted in accordance with the checking results (page 15, lines 1 through 17).

Regarding *claim 4*, Kulakowski discloses the apparatus discussed in claim 1 above, and further teaches of a means (directory 75) for registering in advance e-mail address information of the e-mail destination in correspondence with numeral information (page 12, line 33 through page 13, line 10), wherein the transfer destination information is received as numeral information (page 13, lines 1 and 2), and the address information of the e-mail destination corresponding to the received numeral information is read out from the storage means to designate the e-mail destination (page 13, lines 2 through 10).

Regarding *claim 5*, Kulakowski discloses the apparatus discussed in claim 3 above, and further teaches that the password information is received as numeral information (page 13, lines 19 through 25, and page 10, lines 31 through 34).

Regarding *claim 6*, Kulakowski discloses the apparatus discussed in claim 1 above, and further teaches that the transfer destination information is received by a tone signal (page 12, lines 5 through 14).

Regarding *claim 7*, Kulakowski discloses the apparatus discussed in claim 6 above, and further teaches that the tone signal is a DTMF signal (page 12, lines 5 through 14).

Regarding *claim 8*, Kulakowski discloses the apparatus discussed in claim 1 above, and further teaches of a means for selecting whether the public telephone network is released or facsimile reception via the public telephone network is started (page 9, lines 7 through 30, and

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column 12, lines 5 through 21), when the transfer destination information and a signal related to a facsimile communication are not received within a prescribed time for monitoring signal reception from the public telephone network after call reception from the public telephone network (page 12, lines 14 through 29, and page 16, lines 28 through 33).

Regarding *claim 9*, Kulakowski discloses the apparatus discussed in claim 4 above, and further teaches that the transfer destination information is received by a protocol signal of a facsimile communication protocol (page 12, lines 5 through 32).

Regarding *claim 11*, Kulakowski discloses the apparatus discussed in claim 9 above, and further teaches that the protocol signal of the facsimile communication protocol is a subaddress signal or selective polling signal of the T.30 recommendation (page 12, lines 14 through 29, and page 16, lines 28 through 33).

Regarding *claim 13*, Kulakowski discloses a communication method (see Fig. 5) for a communication apparatus (interface device 10, see Figs. 1 and 2) which is connected to a computer network (network 20, page 8, lines 8 through 15) and a public telephone network (PSTN, page 8, lines 6 through 8), and has a facsimile communication function (see abstract), comprising a step of receiving a remote instruction (destination telephone numbers) from the public telephone network (page 9, lines 7 through 11, page 12, lines 5 through 14, and page 12, line 33 through page 13, line 10), a step of converting the received facsimile image data (page 12, lines 18 through 32) into an e-mail data format (page 13, line 11 through page 14, line 19), and a step of designating an e-mail destination of the computer network in accordance with the received

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remote instruction (page 12, line 33 through page 13, line 10), and transmitting the converted e-mail data to the designated destination (page 15, lines 1 through 17).

Regarding *claim 14*, Kulakowski discloses the method discussed in claim 13 above, and further teaches that the remote instruction includes transfer destination information and password information (page 13, lines 23 through 25) of e-mail data (page 8, lines 22 through 23, and page 13, lines 11 through 31), wherein it is checked if e-mail transfer destination information corresponding to the transfer destination information is set in advance (page 13, lines 11 through 31) and if the received password information matches password information set in advance (being inherent in the system), and the converted e-mail data is transmitted in accordance with the checking results (page 15, lines 1 through 17).

Regarding *claim 15*, Kulakowski discloses the method discussed in claim 14 above, and further teaches of a step of designating the e-mail destination of the computer network on the basis of the received transfer destination information (page 12, line 33 through page 13, line 10), and designating a desired post-office in an e-mail server of the computer network (page 15, lines 1 through 17, and page 17, lines 6 through 34).

Regarding *claim 16*, Kulakowski discloses the method discussed in claim 14 above, and further teaches of a step of registering in advance e-mail address information of the e-mail destination in storage means in correspondence with numeral information (page 12, line 33 through page 13, line 10), and receiving the transfer destination information as numeral information, (page 13, lines 1 and 2), and reading out the address information of the e-mail

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destination corresponding to the received numeral information from the storage means to designate the e-mail destination (page 13, lines 2 through 10).

Regarding *claim 17*, Kulakowski discloses the method discussed in claim 14 above, and further teaches that the password information is received as numeral information (page 13, lines 19 through 25, and page 10, lines 31 through 34).

Regarding *claim 18*, Kulakowski discloses the method discussed in claim 14 above, and further teaches that the transfer destination information is received by a tone signal (page 12, lines 5 through 14).

Regarding *claim 19*, Kulakowski discloses the method discussed in claim 18 above, and further teaches that the tone signal is a DTMF signal (page 12, lines 5 through 14).

Regarding *claim 20*, Kulakowski discloses the method discussed in claim 14 above, and further teaches of a step of selecting whether the public telephone network is released or facsimile reception via the public telephone network is started (page 9, lines 7 through 30, and column 12, lines 5 through 21), when the transfer destination information and a signal related to a facsimile communication are not received within a prescribed time for monitoring signal reception from the public telephone network after call reception from the public telephone network (page 12, lines 14 through 29, and page 16, lines 28 through 33).

Regarding *claim 21*, Kulakowski discloses the method discussed in claim 14 above, and further teaches that the transfer destination information is received by a protocol signal of a facsimile communication protocol (page 12, lines 5 through 32).

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Regarding *claim 23*, Kulakowski discloses the method discussed in claim 21 above, and further teaches that the protocol signal of the facsimile communication protocol is a subaddress signal or selective polling signal of the T.30 recommendation (page 12, lines 14 through 29, and page 16, lines 28 through 33).

Regarding *claim 25*, Kulakowski discloses a storage medium (memory 34 which stores a computer program executed by a computer (page 10, lines 1 through 9) of a communication apparatus (interface device 10, see Figs. 1 and 2) which is connected to a computer network (network 20, page 8, lines 8 through 15) and a public telephone network (PSTN, page 8, lines 6 through 8), and has a facsimile communication function (see abstract), wherein the computer program includes processing of receiving a remote instruction (destination telephone numbers) from the public telephone network (page 9, lines 7 through 11, page 12, lines 5 through 14, and page 12, line 33 through page 13, line 10), processing of receiving facsimile image data via the public telephone network (page 12, lines 18 through 32), processing of converting the received facsimile image data into an e-mail data format (page 13, line 11 through page 14, line 19), and a processing of designating an e-mail destination of the computer network in accordance with the received remote instruction (page 12, line 33 through page 13, line 10), and transmitting the converted e-mail data to the designated destination (page 15, lines 1 through 17).

Regarding *claim 26*, Kulakowski discloses the medium discussed in claim 25 above, and further teaches that the remote instruction includes transfer destination information and password information (page 13, lines 23 through 25) of e-mail data (page 8, lines 22 through 23, and page

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13, lines 11 through 31), wherein it is checked if e-mail transfer destination information corresponding to the transfer destination information is set in advance (page 13, lines 11 through 31) and if the received password information matches password information set in advance (being inherent in the system), and the converted e-mail data is transmitted in accordance with the checking results (page 15, lines 1 through 17).

Regarding *claim 27*, Kulakowski discloses the medium discussed in claim 26 above, and further teaches that the program has processing of designating the e-mail destination of the computer network on the basis of the received transfer destination information (page 12, line 33 through page 13, line 10), and designating a desired post-office in an e-mail server of the computer network (page 15, lines 1 through 17, and page 17, lines 6 through 34).

Regarding *claim 28*, Kulakowski discloses the medium discussed in claim 26 above, and further teaches that the program has processing of registering in advance e-mail address information of the e-mail destination in storage means in correspondence with numeral information (page 12, line 33 through page 13, line 10), and processing of receiving the transfer destination information as numeral information, (page 13, lines 1 and 2), and reading out the address information of the e-mail destination corresponding to the received numeral information from the storage means to designate the e-mail destination (page 13, lines 2 through 10).

Regarding *claim 29*, Kulakowski discloses the medium discussed in claim 26 above, and further teaches that the program has processing of receiving the password information as numeral information (page 13, lines 19 through 25, and page 10, lines 31 through 34).

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Regarding *claim 30*, Kulakowski discloses the medium discussed in claim 26 above, and further teaches that the program has processing of receiving the transfer destination information by a DTMF signal (page 12, lines 5 through 14).

Regarding *claim 31*, Kulakowski discloses the medium discussed in claim 26 above, and further teaches the program has processing of selecting whether the public telephone network is released or facsimile reception via the public telephone network is started (page 9, lines 7 through 30, and column 12, lines 5 through 21), when the transfer destination information and a signal related to a facsimile communication are not received within a prescribed time for monitoring signal reception from the public telephone network after call reception from the public telephone network (page 12, lines 14 through 29, and page 16, lines 28 through 33).

Regarding *claim 32*, Kulakowski discloses the medium discussed in claim 26 above, and further teaches that the program has processing of receiving the transfer destination information by a protocol signal of a facsimile communication protocol (page 12, lines 5 through 32).

Regarding *claim 34*, Kulakowski discloses the medium discussed in claim 26 above, and further teaches that the program has processing of receiving the transfer destination information by a subaddress signal or selective polling signal of the T.30 recommendation (page 12, lines 14 through 29, and page 16, lines 28 through 33).

Regarding *claim 36*, Kulakowski discloses a communication system including a communication apparatus (interface device 10, see Figs. 1 and 2) which is connected to a computer network (network 20, page 8, lines 8 through 15) and a public telephone network

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(PSTN, page 8, lines 6 through 8), and has a facsimile communication function (see abstract) and an e-mail server of the computer network (network service provider's 18, 22, or 32, page 8, lines 8 through 33), wherein the communication apparatus receives facsimile image data via the public telephone network (page 12, lines 18 through 32) upon reception of a remote instruction (destination telephone numbers) from the public telephone network (page 9, lines 7 through 11, page 12, lines 5 through 14, and page 12, line 33 through page 13, line 10), converts the received facsimile image data into an e-mail data format (page 13, line 11 through page 14, line 19), and transmits the e-mail data by designating an e-mail destination in accordance with received remote instruction (page 15, lines 1 through 17), and the e-mail server receives the transmitted e-mail data in a post-office corresponding to the e-mail destination (page 15, lines 1 through 17, and page 17, lines 6 through 34).

Regarding *claim 37*, Kulakowski discloses a communication apparatus (interface device 10, see Figs. 1 and 2) comprising a means for connecting various types of networks (see Fig. 1, and page 8, lines 6 through 15) which have unique format and address respectively (page 12, lines 5 through 14, and lines 33 through 36), a means for receiving information data with destination address data via the networks (page 12, lines 5 through 32), a means (processor 33) for changing a format of the destination address data into another format corresponding to another type of network (page 13, lines 1 through 10).

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Regarding *claim 38*, Kulakowski discloses the apparatus discussed in claim 37 above, and further teaches that the types of networks include a local area network (LAN, page 5, lines 1 through 8, and page 9, lines 1 through 4).

Regarding *claim 39*, Kulakowski discloses the apparatus discussed in claim 37 above, and further teaches that the types of networks include a public telephone network (PSTN, page 8, lines 3 through 15).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 10, 12, 22, 24, 33, and 35** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulakowski (WIPO Publication Number WO 97/10,668) in view of Murphy (U.S. Patent Number 6,028,679).

Regarding *claim 10*, Kulakowski discloses the apparatus discussed in claim 5 above, but fails to specifically teach if the password information is received by a protocol signal of a facsimile communication protocol. Murphy discloses a communication apparatus which includes receiving password information by a protocol signal of a facsimile communication protocol

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(column 3, lines 25 through 47, and Fig. 3). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Murphy's teachings in Kulakowski's system, therein having the password information is received by a protocol signal of a facsimile communication protocol. Kulakowski's system would have better security, as a password would be required to be entered by the sending facsimile machine, as recognized by Murphy.

Regarding *claim 12*, Kulakowski and Murphy disclose the apparatus discussed in claim 10 above, and Kulakowski further teaches that the facsimile communication protocol (page 12, lines 5 through 32) is a selective polling signal of the T.30 recommendation (page 12, lines 14 through 29, and page 16, lines 28 through 33). With the addition of Murphy's teachings of having the password information being received by a facsimile communication protocol, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the password signal of the T.30 recommendation. Kulakowski's system would have better security, as a password would be required to be entered by the sending facsimile machine, as recognized by Murphy.

Regarding *claim 22*, Kulakowski discloses the method discussed in claim 14 above, but fails to specifically teach if the password information is received by a protocol signal of a facsimile communication protocol. Murphy discloses a communication apparatus with a method which includes receiving password information by a protocol signal of a facsimile communication protocol (column 3, lines 25 through 47, and Fig. 3). Therefore, it would have been obvious to a

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person of ordinary skill in the art at the time the invention was made to include Murphy's teachings in Kulakowski's system, therein having the password information is received by a protocol signal of a facsimile communication protocol. Kulakowski's system would have better security, as a password would be required to be entered by the sending facsimile machine, as recognized by Murphy.

Regarding *claim 24*, Kulakowski and Murphy disclose the method discussed in claim 22 above, and Kulakowski further teaches that the facsimile communication protocol (page 12, lines 5 through 32) is a selective polling signal of the T.30 recommendation (page 12, lines 14 through 29, and page 16, lines 28 through 33). With the addition of Murphy's teachings of having the password information being received by a facsimile communication protocol, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the password signal of the T.30 recommendation. Kulakowski's system would have better security, as a password would be required to be entered by the sending facsimile machine, as recognized by Murphy.

Regarding *claim 33*, Kulakowski discloses the medium discussed in claim 26 above, but fails to specifically teach of the program further has processing of receiving the password information by a protocol signal of a facsimile communication protocol. Murphy discloses a communication apparatus which includes receiving password information by a protocol signal of a facsimile communication protocol (column 3, lines 25 through 47, and Fig. 3). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to

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include Murphy's teachings in Kulakowski's system, therein having the password information is received by a protocol signal of a facsimile communication protocol. Kulakowski's system would have better security, as a password would be required to be entered by the sending facsimile machine, as recognized by Murphy.

Regarding *claim 35*, Kulakowski discloses the medium discussed in claim 26 above, and further teaches of the program further has processing that the facsimile communication protocol (page 12, lines 5 through 32) is a selective polling signal of the T.30 recommendation (page 12, lines 14 through 29, and page 16, lines 28 through 33). However, Kulakowski fails to specifically teach of receiving the password information by a password signal of the T.30 recommendation. Murphy discloses a communication apparatus which includes receiving password information by a protocol signal of a facsimile communication protocol (column 3, lines 25 through 47, and Fig. 3). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Murphy's teachings in Kulakowski's system, therein having the password information is received by a protocol signal of a facsimile communication protocol. With the addition of Murphy's teachings of having the password information being received by a facsimile communication protocol, it would further have been obvious to a person of ordinary skill in the art at the time the invention was made to have the password signal of the T.30 recommendation. Kulakowski's system would have better security, as a password would be required to be entered by the sending facsimile machine, as recognized by Murphy.

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Citation of Pertinent Prior Art

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Freeman (U.S. Patent Number 6,020,980) discloses a system for delivering facsimile messages to electronic mail addresses;

Toyoda *et al.* (U.S. Patent Number 5,812,278) discloses a system of receiving a facsimile through a PSTN and transmitting via a LAN or Internet as electronic mail (see Fig. 21);

Gordon (U.S. Patent Number 5,608,786) discloses a system of transmitting facsimile messages to a server through a PSTN, converting the messages, and forwarding them as electronic mail over the Internet;

Wilkes *et al.* (WIPO Publication Number WO 97/26,753) discloses a system which sends facsimile messages over the Internet.

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Conclusion


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles, can be reached on (703) 305-4712. The fax phone number for this Group is (703) 306-5406.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800/4700.

Joseph R. Pokrzywa

September 13, 2000


EDWARD L. COLES
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